

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte WILLIAM J. JOHNSON, ROBERT S. KELLER  
and GEORGE C. MANTHURUHIL

---

Appeal No. 94-3999  
Application 08/083,863<sup>1</sup>

---

ON BRIEF

---

Before URYNOWICZ, JERRY SMITH and TORCZON, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 18-23<sup>2</sup>.

---

<sup>1</sup> Application for patent filed June 28, 1993. According to appellants, this is a continuation of Application 07/793,748, filed November 18, 1991.

<sup>2</sup> Appellants' amendment filed July 22, 1993 (Paper No. 12) contains two claims 22, one an  
(continued...)

The invention pertains to a system and method which permits user access to computer systems.

Claim 18 is illustrative and reads as follows:

18. A method for controlling access to a particular resource among a plurality of resources within a computer system, said computer system including a plurality of software applications, a plurality of files and a display system for displaying a plurality of graphically manipulatable iconic representations, said method comprising the computer implemented steps of:

specifying a finite ordered series of substantive activities which may be performed by a user within said computer system, said finite ordered series of substantive activities including at least one activity from a list including: invocation of a selected software application; manipulation of a selected file within a software application; and, graphic manipulation of a selected iconic representation;

allowing apparent access to said computer system by a selected user wherein said selected user may access each of said plurality of resources except said particular resource; and

permitting said selected user to access said particular resource only in response to a performance by said selected user of said specified finite ordered series of substantive activities within said computer system.

The references relied upon by the examiner as evidence of anticipation are:

Moore et al. (Moore)	4,697,243	Sep. 29, 1987
Rosen et al. (Rosen)	4,731,841	Mar. 15, 1988
Smith	4,956,769	Sep. 11, 1990
Berry	4,964,163	Oct. 16, 1990
Piosenka et al. (Piosenka)	4,993,068	Feb. 12, 1991
Greanias et al. (Greanias)	5,007,085	Apr. 09, 1991

---

(...continued)

independent apparatus claim and the other an apparatus claim depending from dependent method claim 21. Because the errors with respect to dependent claim 22 are manifest, dependent claim 22 is being treated as though it is claim 24 which depends from independent claim 22.

As filed, apparatus claim 23 depends from dependent method claim 21. This is manifest error and claim 23 is being treated as though it depends from independent apparatus claim 22.

Appeal No. 94-3999  
Application 08/083,863

Jones

5,144,659

Sep. 01, 1992

Claims 18-24 stand rejected under 35 U.S.C. § 101 as drawn to non-statutory subject matter.

Claims 18-24 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 18-24 stand rejected under 35 U.S.C. § 102 (b or e) as being anticipated by any of Moore, Rosen, Smith, Berry, Piosenka, Greanias or Jones.

The respective positions of the examiner and the appellants with regard to the propriety of these rejections are set forth in the final rejection (Paper No. 13) and the examiner's answer (Paper No. 16), and the appellants' brief (Paper No. 15).

#### Appellants' Invention

The invention is directed to a system which permits a user to access a computer system while providing a level of security similar to that provided by password systems. A finite ordered series of substantive activities, such as icon manipulations, application invocations or file manipulations are stored in the system for future reference. Each time access to the computer system is attempted, the initial activities of a user are identified and compared to the stored finite ordered series of substantive activities. Access is validated and continued access is permitted in

response to a match between the prospective user's initial activities and the stored finite ordered series

Appeal No. 94-3999  
Application 08/083,863

of substantive activities. In this manner, access to a computer system may be validated without the necessity of utilizing an explicit access/password scheme which may be compromised.

#### The Prior Art

Each of the references relates to a security system wherein an express challenge of some type is made to a user of a system. Continued access to the system requires a proper response by the user to the challenge.

#### Opinion

We will not sustain the rejections under 35 U.S.C. § 101 or 35 U.S.C. § 112, second paragraph. We will sustain the rejection under 35 U.S.C. § 102.

#### The Rejection under 35 U.S.C. § 101

With respect to this rejection, the examiner's position is that the claims are not statutory because they are drawn to nothing more than a mental process controlling the performance of certain activities or a method of doing business. It is urged that the claims require nothing more than the interaction between an individual human operator and a computer.

Whether claims are directed to subject matter within this stature should not turn on whether the claimed invention does business instead of something else. State Street Bank &

Appeal No. 94-3999  
Application 08/083,863

Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1377, 47 USPQ2d 1596, 1604 (Fed.

Cir. 1998). Accordingly, to the extent it is urged the claims are unstatutory because they are drawn to a method of doing business, the rejection cannot be sustained.

The examiner's position to the effect that the claims are unpatentable because they are directed to an abstract idea is not persuasive because they do not merely define an abstract idea. The question of whether claims encompass statutory subject matter should focus on the essential characteristics of the subject matter, in particular, its practical utility. State Street Bank & Trust Co. v. Signature Financial Group, Inc., *supra*. Here, claims 18-21 define a process of "computer implemented steps" for controlling access to a particular resource within a computer system, and claims 22-24 define a machine for controlling access to a particular resource within a computer system.

The Rejection under 35 U.S.C. § 112, Second Paragraph

As to this rejection, it is asserted that appellants claim steps as "activities which may be performed". The examiner contends that the functions as claimed are not positive limitations and render the claims ambiguous. Purportedly, there is no requirement that any act be performed. Still further, the examiner contends that it is not clear what is meant by the claim language "finite ordered series of activities".

With respect to the first-mentioned position of the examiner in the above paragraph, claims 22-24 are apparatus claims having means plus function clauses. The three elements of

claim 22 are “means of storing”, “access means for allowing access” and “access control means for permitting said selected user to access said particular resource”. Dependent claims 23 and 24 add “means for automatically executing” and “means for automatically invoking”, respectively. The examiner has not specifically addressed any of these clauses to show how it renders one or more of the claims ambiguous. Nor do we find ambiguity in any of the clauses or in any of the other language in these claims when read in light of appellants’ disclosure. In re Moore, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

The first step of sole independent method claim 18 is “specifying”. The language setting forth this step includes the term “activities which may be performed” which the examiner has criticized. The language “which may be performed” modifies “activities”, not the method step of “specifying”. Thus, “specifying a finite ordered series of substantive activities” is a positive limitation of claim 18 and we find no merit to the examiner’s position to the effect that claims 18-21 are indefinite or ambiguous because this step is not positively set forth.

Although the claim language “finite ordered series of substantive activities” is not defined in the claims as noted by the examiner, this language is defined in appellants’ specification. Substantive activities are defined at page 8, lines 14-22 of appellants’ specification as activities having substantive effect within a computer system or application rather than the mere entry of an arbitrary alphanumeric key sequence, such as is typically used in a password process. Examples of substantive activities are given as invocation of a particular application, the

manipulation of a selected file, manipulation of a particular icon or the utilization of a peripheral system.

A finite ordered series of substantive activities would be two or more sequential, substantive activities.

Accordingly, the meaning of this claim language is clear from appellants' specification.

The Rejection under 35 U.S.C. § 102

Appellants have argued the patentability of the claims at bar without drawing any distinction between the claims. Accordingly, the claims stand or fall together. In re Nielson, 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

After consideration of the positions and arguments presented by both the examiner and the appellants, we have concluded that this rejection should be sustained. We agree in general with the comments made by the examiner; we add the following discussion for emphasis.

The examiner's position is to the effect that the claims are broad and that they are anticipated by any computer access granting process including those of the cited prior art references, and that the claims are readable on the mere activation of windows in the DOS environment or the activation of any application in the Apple Macintosh environment. It is argued that any time an operator double clicks on an icon, or resets the control panel to allocate a specific resource, the operator performs a substantive activity. The references are relied on as teaching computer systems wherein substantive activities are performed.

In response to the examiner's position that the claims are anticipated by each of the prior art references, appellants state that each reference teaches an express challenge of some type which makes it clear that continued access to the system by a user requires a response. The only argument made by appellants is to the effect that in contrast, the object of the present invention is to provide a method for controlling access to a computer system in a manner which does not utilize an express password scheme similar to those in the references, and that appellants' method is expressly brought out in the claims by calling for a user to perform a "finite ordered series of substantive activities".

It is considered that appellants have not specifically addressed the examiner's position in the rejection, and we are persuaded by that position. Appellants have made much of the fact that the references teach password schemes. This is not relevant to the rejection. The issue is whether the references teach a finite ordered series of substantive activities as defined by appellants for use in accessing computer systems. The examiner is correct that in accessing computer systems such as taught in the references, a user performs a finite ordered series of substantive activities to access a particular resource, such as the memory where a particular file is stored. Activities such as invocation of a selected software application, manipulation of a selected file and graphical manipulation of icons on a screen by a computer operator to access a particular resource are at least as old as personal computers themselves.



Appeal No. 94-3999  
Application 08/083,863

Summary

In summary:

a) the decisions of the examiner to reject claims 18-24 under 35 U.S.C. §§ 101 and 112 are reversed.

a) the decision of the examiner to reject claims 18-24 under 35 U.S.C. § 102 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR§ 1.136(a).

AFFIRMED

STANLEY M. URYNOWICZ, JR.  
Administrative Patent Judge

JERRY SMITH  
Administrative Patent Judge

RICHARD TORCZON  
Administrative Patent Judge

)  
)  
)  
)  
) BOARD OF PATENT  
) APPEALS AND  
) INTERFERENCES  
)  
)  
)  
)  
)

SMU/dal

Appeal No. 94-3999  
Application 08/083,863

ANDREW J. DILLON  
FELSMAN, BRADLEY, GUNTER  
and DILLON, LLP  
STE. 350, LAKEWOD ON THE PARK  
7600B NORTH CAPITAL OF TEXAS HIGHWAY  
AUSTIN, TEXAS 78731